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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,393	11/10/2003	Ron Clark	T5353.A.CON3	4403
20449	7590	09/21/2007		
KARL R CANNON PO BOX 1909 SANDY, UT 84091			EXAMINER SHAFFER, RICHARD R	
			ART UNIT 3733	PAPER NUMBER
			MAIL DATE 09/21/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/705,393	CLARK ET AL.	
	Examiner	Art Unit	
	Richard R. Shaffer	3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 42-93 is/are pending in the application.
- 4a) Of the above claim(s) 44-60, 63-66, 68-71, 81, 82, 85, 86 and 90-93 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 42, 43, 61, 62, 67, 72-80, 83, 84 and 87-89 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of a Metal Securing Material and Patellar Tendon implant in the reply filed on January 22<sup>nd</sup>, 2007 is acknowledged. Applicant's additional election with traverse of the implant structure as shown in Figure 1 in the reply filed on June 21<sup>st</sup>, 2007 is also acknowledged. The traversal is on the ground(s) that the searching of the various species would not pose a serious burden on the examiner and that the structure of the various species are sufficiently similar. This is not found persuasive because searching for all of the different species would be a serious burden given the numerous species in each election group thereby creating hundreds of possibilities that must be taken into account. Further, as stated previously, the structure is currently found to be patentably distinct and applicant was given the opportunity to state that the species were obvious variants of one another.

The requirement is still deemed proper and is therefore made FINAL.

Claims 44-60, 63-66, 68-71, 81, 82, 85, 86 and 90-93 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the replies filed on January 22<sup>nd</sup>, 2007 and June 21<sup>st</sup>, 2007.

### ***Claim Objections***

Claim 74 is objected to because it is unclear what direction is intended when applicant states "the direction in which the shaft is inserted." This is because the shaft is initially inserted into the drilled hole and then subsequently "inserted" into the securing means. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 42, 43, 67, 72-78, 87 and 89 are rejected under 35 U.S.C. 102(e) as being anticipated by West, Jr. et al (US Patent 5,964,764).

West, Jr. et al disclose (**Figures 1-8**) a method comprising: drill a hole (**46**) through the bone of a patient; attaching a bone patellar tendon bone implant (**42**) to an anatomical structure other than the bone (the other bone in the joint); inserting through the drilled hole an attachment member comprising a hook (**35**) with a shaft (**20**); the shaft having locking means (the slanted portions leading to **32** as well as **32** itself; the locking means of the shaft (**20**) interact with a push nut (**24**) with receiving means (**26** and **28**); grasping the free end of the implant with the grasping hook; and securing the implant to the securing means increasing tension along the implant before finalizing the

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secured position of the shaft and securing means. In **Figure 8**, one can see an enlarged portion of the drilled hole. In **Column 12, Lines 28-42**, it is stated that the entire device can be located within the drilled bore if desired.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 61, 62, 79, 80, 83, 84 and 88 are rejected under 35 U.S.C. 103(a) as being unpatentable over West Jr. et al.

West Jr. et al disclose all of the claimed limitations except for the device being made of metal from the group of titanium, stainless steel, cobalt-chromium-molybdenum alloy, titanium-aluminum vanadium alloy, and other alloys thereof as well as explicitly stating that a tension measuring device is utilized.

It would have been obvious to one having ordinary skill in the art at the time of invention to manufacture the device of West Jr. et al from an alloy claimed since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Further, since West Jr. et al already were concerned about tension being applied on the ligament and in regards to properly treating a knee, one would naturally measure the tension to ensure the knee is balanced and properly corrected for stability. It would

have been obvious to one having ordinary skill in the art at the time of invention to provide a tension-measuring device in order to ensure the knee was properly corrected.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard R. Shaffer whose telephone number is 571-272-8683. The examiner can normally be reached on Monday-Friday (7am-5pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Richard Shaffer  
September 15<sup>th</sup>, 2007



EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER